

REMARKS

In response to the Office Action dated July 5, 2007. Applicant submits the following remarks.

In the Office Action, the Examiner issued a requirement that Applicants make an election between the Group I claims (Claims 1-14), the Group II claims (Claims 15-26), and the Group III claims (Claims 27-38). Applicants hereby elect Group II but this election is made with traverse and is solely for the purpose of advancing prosecution of this case. It is believed that the requirement to restrict the invention is improper. The claims are sufficiently related that their respective classes would be thoroughly cross-referenced, and many of the same classes would be searched regardless of which group of claims was elected.

The Group I claims are directed to method for preventing termite tunneling and tubing on non-wood materials by applying borates to the surfaces thereof. The Group II claims are directed to method for preventing termite damage to man-made structures by coating a non-wood building component with a borate solution. The Group III claims are directed to a non-wood building component which has been coated with borates. Hence all three sets of claims require that a search for borated-coated non-wood building materials be made.

An examination of the Group II claims will require a search of the same prior art as an examination of the Group I and Group III claims. Each would require searching all of the art relating to borated-coated non-wood building materials. Furthermore, separate examination of the Group I, Group II, and Group III claims may lead to inconsistent examinations and likely will result in duplication of effort. It is therefore a more efficient use of Patent Office manpower and resources to examine all claims which are closely related at one time rather than conducting separate examinations.

The mere fact that one set of claims is directed to a method and the other set is directed to an apparatus does not mean a patent cannot be issued containing both sets of claims. Patents are routinely issued containing method and apparatus or method and product claims.

Moreover, restriction is not "required" by 35 U.S.C. §121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be

restricted...." (emphasis added). Likewise, the MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

Because the Examiner has not shown any serious burden if examination of all the claims is conducted and the claims cover closely related subject matter, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement and examine Claims 1 - 38.

In addition, the Examiner has issued three separate election of species requirements. First, the Examiner takes the position that the claims are directed to patentably distinct species based upon the type of borates used in the invention. In the Office Action, the Examiner mentioned only boric acid and sodium borates as species. It is noted, however, that Claim 9 includes "boric acid, sodium borates, zinc borates, calcium borates, sodium calcium borates, calcium magnesium borates, and organic borates." From this group, Applicants hereby elect the sodium borates species but this election is made with traverse and is solely for the purpose of advancing prosecution of this case.

Secondly, the Examiner takes the position that the claims are directed to patentably distinct species based upon the type of building components for use in the invention, i.e., cement, metal, and polymer. From this group, Applicants hereby elect the cement species. This election is also made with traverse.

Finally, the Examiner takes the further position that the claims are directed to patentably distinct species based upon the method of application. While the Examiner only refers to spraying, dipping, and gaseous application methods, the total range of methods included in Claim 10 includes "spraying, dipping, brushing, roller coating, misting, foaming, fogging, powder coating, pressure immersion, [and] gaseous application." From this group, Applicants hereby elect the application by spraying species, and again, this election is also made with traverse.

The claims believed to be readable upon the elected species are as follows:

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July 30, 2007

<u>Elected Species</u>	<u>Corresponding Claims</u>
Sodium Borates	1 – 38
Cement	1 – 5, 8 – 21, 24, – 31, and 34 – 38
Spray Application	1 – 38

With respect to each of the three election of species requirements, the requirement is respectfully traversed because it is believed that the prior art searching for the respective species will significantly overlap. For example, while boric acid and sodium borates may be distinct species in the context of the invention, it is believed that a prior art search directed to one species will require searching much of the same prior art as the other species. A similar situation exists with the different species of building materials (cement, metal, polymeric) and with the different species of method of application (spraying, dipping, brushing, etc.).

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12_2355**.

Respectfully submitted,

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